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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,637	12/14/2001	William Eugene Harvey	17,373	9222

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EXAMINER	
MEINECKE DIAZ, SUSANNA M	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,637	HARVEY ET AL.	
	Examiner	Art Unit	
	Susanna M. Diaz	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/22/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are presented for examination.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (Page 1, line 24). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)*). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson, 409 U.S. at 71-72, 175 USPQ at 676-77*). (Please refer to the "Interim

Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

Claims 1-30 revolve around the steps of calculating a base preference for a product, calculating a downside for the product, and calculating an upside for the product. However, the claimed invention does not incorporate a useful result. In other words, it is not clear why these calculations are useful. Also, these calculations are never applied to produce a real-world result; therefore, the claims do not produce a tangible result. In conclusion, claims 1-30 are deemed to be non-statutory for failure to produce a useful and tangible result.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that a base preference, a downside, and an upside for a product are calculated. A product base preference, downside, and upside seem to be based on a test subject's subjective opinion and therefore cannot be derived from a calculation. Without any clarification of the intended scope of the base preference, downside, and

upside of a product as per the language of claim 1, the metes and bounds of each respective aspect of the product are unclear.

Claim 2 recites that "no test subject prefers the product on its delivery of the attribute"? This phrase is ambiguous. How can a test subject prefer a product without any relation to an attribute preference? Furthermore, what is the "delivery" of an attribute as opposed to the preference for an attribute itself?

It is not clear whether the ratio recited in claim 3 is part of an actual mathematical formula or just a comparison of two values, especially since the ratio is never used for any real-world application. In other words, is the recited ratio an actual, meaningful quantitative value or does it merely refer to a general comparison of two values, such as a subjective comparison assessed by a human? Even if the comparison is made by a computer, would such a comparison yield a useful result or could it still be a general comparison, such as the display of these two compared values on a computer screen?

Claim 4 recites that "the downside is the incremental overall preference above the base preference attributable to the attribute." A downside implies a negative attitude; therefore, it is not understood why a downside would be a preference above the base preference attributable to an attribute. It seems that, instead, a downside would be reflected as a preference below a base preference attributable to an attribute.

Claim 5 recites that the downside for the product is calculated by taking the difference between a base preference and an overall preference. Claim 1 does not clearly define the scope of a base preference, a downside, and an upside for a product (as discussed above); therefore, it is not clear how the difference between the base

preference and overall preference yields a downside for a product. Furthermore, claim 2 defines the base preference as the overall preference for a product. If this definition were read into claim 5, the downside for the product would be zero since the base preference equals the overall preference for the product. There is no comparison to be made between two equivalent versions of the same preference (i.e., the overall and base preferences).

Claim 6 recites that "the upside is the incremental overall preference attributable to the maximum potential attribute preference." What is an "*incremental* overall preference"?

There is no antecedent basis for "the overall preference" and "the best preference" in line 2 of claim 7.

It is not clear whether the ratio recited in claim 7 is part of an actual mathematical formula or just a comparison of two values, especially since the ratio is never used for any real-world application. In other words, is the recited ratio an actual, meaningful quantitative value or does it merely refer to a general comparison of two values, such as a subjective comparison assessed by a human? Even if the comparison is made by a computer, would such a comparison yield a useful result or could it still be a general comparison, such as the display of these two compared values on a computer screen? Also, how does the difference between an overall preference and the ratio between an overall preference and a preference due to an attribute yield any significant number reflective of an upside? How are these preferences quantitatively expressed in such a manner that the "upside" equals a meaningful value?

Claims 8-30 recite similar limitations as those recited in claims 1-7; therefore, the same rejections under 35 U.S.C. § 112, 2nd paragraph apply.

Appropriate correction and/or clarification is required.

The following art rejection reflects Examiner's best understanding of the claimed invention in light of the numerous rejections under 35 U.S.C. §§ 101 and 112, 2nd paragraph.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bauer et al. (WO 98/18352 A1).

Bauer discloses a method for determining preference results for a product having an attribute, the method comprising:

[Claim 1] calculating a base preference for the product (Page 15, "Test Design: Paired Comparison" table);

calculating a downside for the product (Page 15, "Test Design: Paired Comparison" table); and

calculating an upside for the product (Page 15, "Test Design: Paired Comparison" table);

[Claim 2] wherein the base preference is the overall preference for the product where no test subject prefers the product on its delivery of the attribute (Page 15, "Test Design: Paired Comparison" table – "Overall Preference");

[Claim 3] wherein the base preference is the ratio of the number of test subjects who preferred the product overall but not with respect to the attribute to the number of test subjects who did not prefer the product with respect to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 4] wherein the downside is the incremental overall preference about the base preference attributable to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 5] wherein calculating the downside for the product includes taking the difference between a base preference and an overall preference, wherein the overall preference is the ratio of the number of test subjects who preferred the product overall to the total number of test subjects (Page 15, "Test Design: Paired Comparison" table;

Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.");

[Claim 6] wherein the upside is the incremental overall preference attributable to the maximum potential attribute preference (Page 15, "Test Design: Paired Comparison" table);

[Claim 7] wherein calculating an upside for the product includes taking the difference between the overall preference and the best preference, where the best preference is the ratio of the number of test subjects who preferred the product both overall and with respect to the attribute to the number of test subjects who preferred the product with respect to the attribute (Page 15, "Test Design: Paired Comparison" table; Page 15, "Surprisingly, consumers were shown to prefer the foaming embodiment of identical cleaning compositions by a greater than 2:1 margin. Interestingly, the foaming article was perceived as performing with less 'Sliminess' and as only fractionally more difficult to rinse off.").

[Claims 8-19] Claims 8-19 recite limitations already addressed by the rejection of claims 1-7 above; therefore, the same rejection applies.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (WO 98/18352 A1).

[Claims 20-30] Claims 20-30 recite limitations already addressed by the rejection of claims 1-7 above; therefore, the same rejection applies.

Furthermore, as per claims 20 and 21, while Bauer teaches the matrix of responses including preference results by input choices (Page 15, "Test Design: Paired Comparison" table), Bauer does not expressly teach that the matrix and corresponding calculation results are generated by a computer and software executed thereon. However, Official Notice is taken that it is old and well-known in the art of automation to utilize software executed by a computer to perform calculations and generate spreadsheets commonly completed by hand. Use of a computer to carry out these functions yields more accurate and rapid generation of calculation and spreadsheet results. Therefore, since Bauer already teaches the recited matrix and calculations, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Bauer to generate the recited matrix and calculations using software executed by a computer in order to yield more accurate and rapid generation of these calculation and spreadsheet (i.e., matrix) results.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foley et al. (U.S. Patent No. 6,623,040) – Discloses a method for determining forced choice consumer preferences by hedonic testing.

Johnston et al. (U.S. Patent No. 6,826,541) – Discloses methods, systems, and computer program products for facilitating user choices among complex alternatives using conjoint analysis.

Areni et al. ("Point-of-Purchase Displays, Product Organization, and Brand Purchase Likelihoods") – Discusses the effect of various product attributes on overall product preference.

Muthukrishnan ("Decision Ambiguity and Incumbent Brand Advantage") -- Discusses the effect of various product attributes on overall product preference.

Kauffman ("Influences on Industrial Buyers' Choice of Products: Effects of Product Application, Product Type, and Buying Environment") -- Discusses the effect of various product attributes on overall product preference.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susanna M. Diaz
Primary Examiner
Art Unit 3623

March 6, 2006